

REMARKS

Claims 22 and 24-28 were examined by the Office, and in the Office Action of August 3, 2010 all claims are rejected. With this response claims 22, 24, 26 and 28 are amended, and claims 25 and 27 are cancelled without prejudice. All new claims are fully supported by the specification as originally filed. Applicant respectfully requests reconsideration and withdrawal of the rejections in view of the following discussion.

Applicant would also like to thank Examiner Pryor for his helpful comments during the telephone interview of October 28, 2010. At the suggestion of the Examiner, applicant has amended independent claims 22 and 24 to include limitations from claims 26 and 28 that further define the aerosol composition, namely that it includes an effective compound that may be selected from one of the compounds now recited in claims 22 and 24.

Claim Rejections Under § 103

On page 2 of the Office Action, claims 22 and 24-28 are rejected under 35 U.S.C. § 103(a) as unpatentable over Hiroshi (JP 11-342202) in view of Katano et al. (JP 10-278982). Applicant respectfully submits that claim 22 is not disclosed or suggested by the cited references, because the cited references fail to disclose or suggest all of the limitations recited in claim 22. The cited references at least fail to disclose or suggest that the aerosol composition has 20 to 70% by weight of liquefied gas and an effective compound, as recited in claim 22. For at least this reason, claim 22 is not disclosed or suggested by the cited references.

The Office acknowledges on page 2 that Hiroshi does not teach that the product contained in the device has 20 to 70% by weight of liquefied gas. The Office also acknowledges on page 3 of the Office Action that Katano also fails to teach this limitation of claim 22. However, the Office further states on page 3 that “it is well within the skill of an artisan in the field to determine the optimum amounts.” A statement that modifications of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art at the time the claimed invention was made” is not sufficient

to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. See MPEP § 2143.01. The Office's assertion to modify the references to arrive at the claimed limitations is in direct contraction to the direction provided by the MPEP. The Office has asserted that the specifically claimed percentage of liquefied gas in the aerosol composition would have been well within the skill of an artisan. However, the MPEP does not allow such an assertion to support a case of obviousness, unless there is some objective reason to modify the references. The only additional support the Office has provided is that "an artisan would have been motivated to do this in order to develop the most safe and effective invention." This assertion is not an objective reason, but rather a mere conclusory statement, because it provides no support for why one of skill in the art would select the percentages claimed in claim 22. Therefore, for at least this reason, claim 22 is not disclosed or suggested by the cited references.

The Office states on page 4 of the Office Action that the claims are drawn to a device and not to a device that includes product. As discussed during the telephone interview, the claims are amended to clarify that they are directed to an intermittent injection aerosol product, and the intermittent injection aerosol product includes an intermittent aerosol dispensing device and an aerosol composition. Claim 22 is further amended to clarify that it is the aerosol composition that comprises 20 to 70 % by weight of a liquefied gas and an effective compound. Accordingly, claim 22 is directed to a product that includes the device and composition. As such, the limitations regarding the composition must be given patentable weight, and for at least the reasons discussed above, claim 22 is not disclosed or suggested by the cited references.

Independent claim 24 contains limitations similar to those recited in claim 22, and is rejected for the same reasons as claim 22. Therefore, for at least the reasons discussed above, claim 24 is not disclosed or suggested by the cited references.

The dependent claims rejected above all ultimately depend from an independent claim, and are not disclosed or suggested by the cited references at least in view of their dependencies.

On page 4 of the Office Action, claims 22 and 24-28 are rejected under 35 U.S.C. § 103(a) as unpatentable over Hiroshi, or Monden (U.S. Patent No. 4,262,823) or Ando (U.S. Patent No. 5,881,925) and Katano. The Office asserts on page 5 of the Office Action that the limitation regarding the percent gas content is not given patentable weight, since it is asserted that the device as claimed is not required to contain a product. As discussed above, the claims are amended to clarify that they are directed to an intermittent injection aerosol product, and the intermittent injection aerosol product includes an intermittent aerosol dispensing device and an aerosol composition. Accordingly, for at least the reasons discussed above, applicant respectfully submits that claim 22 is not disclosed or suggested by the cited references.

Independent claim 24 contains limitations similar to those recited in claim 22, and is rejected for the same reasons as claim 22. Therefore, for at least the reasons discussed above, claim 24 is not disclosed or suggested by the cited references.


The dependent claims rejected above all ultimately depend from an independent claim, and are not disclosed or suggested by the cited references at least in view of their dependencies.

Conclusion

For at least the foregoing reasons, the present application is believed to be in condition for allowance, and such action is earnestly solicited. The undersigned hereby authorizes the Commissioner to charge Deposit Account No. 23-0442 for any fee deficiency required to submit this response.

Respectfully submitted,

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